

### **REMARKS/ARGUMENTS**

The Office Action mailed January 10, 2006 has been received and reviewed. Each of claims 1-34 stands rejected. Reconsideration of the present application in view of the following remarks is respectfully requested.

#### **Rejections based on 35 U.S.C. § 102(b)**

Claims 1-7, 9-13, 15-21, 23-29, and 31-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,513,264 to Wang et al. (hereinafter the "Wang reference"). As the present application properly claims priority to a filing date prior to the patenting date of the Wang reference, Applicant respectfully traverses the rejection as hereinafter set forth.

Applicant respectfully submits that the present application is entitled to a March 12, 1992 filing date. A 35 U.S.C. § 102(b) reference must be "patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States" to be anticipatory. 35 U.S.C. § 102(b). Thus, the Wang reference, patented on April 30, 1996, is not an anticipatory reference under the purview of 35 U.S.C. § 102(b).

The Office Action denies the present application's entitlement to a March 12, 1992 filing date using two independent rationales: (1) "the first link between the instant application and the immediate parent . . . is improper;" and (2) the present application must be "filed before the patenting or abandonment of or termination of proceedings on the first application." Applicant respectfully traverses each stated rationale and respectfully submits that a thorough explanation of the present application and its relationship to MPEP continuation

procedures will elucidate an appropriate filing date for the present application and render all claims patentable.

First, regarding the “first link between the instant application and the immediate parent,” the Office Action asserts that a continuation must be filed “prior to payment of the issue fee.” However, MPEP 201.07 clearly states that “[a] continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes *abandoned or patented*.” The portion of MPEP 201.07 cited by the Office Action, discussing filing prior to payment of the issue fee, applies only to continued prosecution applications (CPAs) under 37 CFR 1.53(d). MPEP 201.07

The present application is a continuation, in contrast to a CPA, and requires a filing date before abandonment or patenting of the prior application as set forth in the continuation portion of MPEP 201.07. Here, the present application was filed on November 4, 2003 and the prior application No. 09/961,697 issued as U.S. Patent No. 6,641,046 on *November 4, 2003*. In accordance with the language of MPEP 201.07, the present application was correctly filed before the prior application was patented. MPEP 201.11(II)(B) further clarifies this point, stating that where “the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed *on the same date*, or before the date that the patent issues on the prior application.” Thus, the present application has effectively established copendency with its immediate parent application, entitling the present application to a filing date of March 12, 1992 as will be discussed below.

Second, regarding the filing date of the present application in relation to the filing date of the earliest prior application, the Office Action states that the present application must be

“filed before the patenting or abandonment of or termination of proceedings on the first application.” The Office Action suggests that the present application must have been filed prior to the patenting or abandonment of the earliest prior application, however, MPEP 201.11(II)(B) indicates otherwise. MPEP 201.11(II)(B), which discusses the appropriate time for filing later-filed applications, states that “the later-filed application must be copending with the prior application *or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date* of the prior application.” Here, as discussed in detail above, the present application was copending with an intermediate nonprovisional application, specifically application No. 09/961,697. Moreover, application No. 09/961,697 was entitled to the benefit of priority dating back to the earliest filed application, specifically, March 12, 1992. Accordingly, in the context of the present application, application No. 09/961,697 was an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application (the March 12, 1992 application).

MPEP 201.11(III)(C) further clarifies this point using, as an example, the exact circumstances of the present case, stating:

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. . . .

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications.

MPEP 201(III)(C) (citations omitted). Here, the present application made all requisite references to each application in the chain, effectively obtaining priority to the earliest application in the chain which was filed on March 12, 1992.

In sum, because the present application maintained copendency with its immediate parent application, and because the present application correctly listed the chain of applications for priority purposes, the effective filing date of the present application is March 12, 1992. It is respectfully submitted that the Wang reference, patented on April 30, 1996, fails to anticipate claims 1-7, 9-13, 15-21, 23-29, and 31-34. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-7, 9-13, 15-21, 23-29, and 31-34 is respectfully requested.

**Rejections based on 35 U.S.C. § 103(a)**

Claims 8, 16, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. (hereinafter the "Wang reference") in view of Sant' Anselmo et al. (hereinafter the "Sant' Anselmo reference"). As the present application properly claims priority to a filing date prior to the patenting date of both the Wang reference and the Sant' Anselmo reference, Applicant respectfully traverses the rejection as hereinafter set forth.

Applicant respectfully submits that the present application is entitled to a March 12, 1992 filing date as discussed in detail above. Thus, the Wang reference, patented on April 30, 1996, and the Sant' Anselmo reference, patented on July 19, 1994, cannot be used as prior art references for obviousness purposes under 35 U.S.C. § 103(a). As discussed above, because the

present application maintained copendency with its immediate parent application, and because the present application correctly listed the chain of applications for priority purposes, the effective filing date of the present application is March 12, 1992 as discussed above. It is respectfully submitted that the Wang reference, patented on April 30, 1996, combined with the Sant' Anselmo reference, patented on July 19, 1994 is insufficient to render claims 8, 16, and 32 obvious because of the present application's earlier filing date. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 8, 16, and 32 is respectfully requested.

Claims 14, 22, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. (hereinafter the "Wang reference") in view of Dvorkis et al. (hereinafter the "Dvorkis reference"). As the present application properly claims priority to a filing date prior to the patenting date of both the Wang reference and the Dvorkis reference (although the Dvorkis reference is a CIP of a CIP of a CIP with a filing date of October 30, 1989), Applicant respectfully traverses the rejection as hereinafter set forth.

Applicant respectfully submits that the present application is entitled to a March 12, 1992 filing date as discussed in detail above. Thus, the Wang reference, patented on April 30, 1996, and the Dvorkis reference, patented on December 13, 1994, cannot be used as prior art references for obviousness purposes under 35 U.S.C. § 103(a). As discussed above, because the present application maintained copendency with its immediate parent application, and because the present application correctly listed the chain of applications for priority purposes, the effective filing date of the present application is March 12, 1992. It is respectfully submitted that the Wang reference, patented on April 30, 1996, combined with the Dvorkis reference, patented on December 13, 1994 is insufficient to render claims 14, 22, and 30 obvious because of the

present application's earlier filing date. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 14, 22, and 30 is respectfully requested.

### CONCLUSION

For the reasons stated above, claims 1-34 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1-34. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

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Respectfully submitted,



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